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JUL 05 2006

REMARKS

Reconsideration of this application is respectfully requested.

In the Official Action, the Examiner requests checking and updating the serial numbers and patent numbers of all related applications listed in the beginning of the application. In response, Applicants respectfully submit that they know of no further updated information.

Furthermore, the Examiner has rejected claims 1-4 and 11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner argues that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner supports his rejection by indicating that the claims include very generic claim limitations (e.g., treatment unit, intermittent output control, subject tissue determining unit and intermittent output setting unit), which are inherently vague due to their plain language definitions and are not described in the specification in the manner of which a professional reviewer of patent applications can follow.

Applicants respectfully disagree with the Examiner's arguments and submit that the Examiner has not set forth a prima facie case for a lack of written description.

Firstly, the CCPA has held that written description requirement is relatively simple to comply with and will ordinarily demand minimal concern from the patent office. *In re Moore*, 439 F.2d 1232, 1235 (CCPA, 1971). Both the CCPA and the Court of Appeals for the Federal Circuit have held that the test for sufficiency of the written description is whether

the disclosure reasonably conveys to persons of ordinary skill in the art that the inventor had possession of the claimed subject matter. *In re Wertheim*, 541 F.2d 257 (CCPA, 1976) and *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991). The fact that the exact words from the claims are not in the specification is not important. *In re Wright*, 866 F.2d 422 (Fed. Cir. 1989).

The Examiner bears the burden of providing a prima facie case to support a rejection under 35 U.S.C. § 112, first paragraph. *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (BPAI, 1987). Generally, to make out a prima facie case, the Examiner must show:

- (1) The Application does not reasonably describe or convey the concepts
- (2) to one of ordinary skill in the art
- (3) at the time of filing the application, and
- (4) that the inventor did not have possession of the claimed invention.

The Examiner only argues that since the claim terms are generic they are inherently vague due to their plain language definitions and therefore are not described in the specification in the manner of which a professional reviewer of patent applications can follow.

However, it is well settled in the U.S. patent laws that applicants are permitted to claim their invention as generically and as broadly as the prior art will permit. The Examiner makes no showing why the terms are generic or why generic terms are inherently broad.

Furthermore, the Examiner argues that the claim terms are vague due to their plain language definitions (emphasis added). In light of the Federal Circuit's holding in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1326 (Fed. Cir. 2005), it is clear that the terms of the

claims are to be construed in light of the specification, not from dictionary or plain language definitions.

Lastly, the Examiner argues that he ("a professional reviewer of patent applications") cannot understand how the claim terms are described in the specification. Applicants respectfully submit that the proper standard for review under 35 U.S.C. § 112, first paragraph, is based on someone of ordinary skill in the art. Thus, the Examiner has not made a showing of any of items 1-4 set forth above with any specificity. Therefore, Applicants respectfully traverse the Examiner's rejection because the Examiner has not made out a prima facie case under 35 U.S.C. § 112, first paragraph.

Although the Examiner has not made out a prima facie case under 35 U.S.C. § 112, first paragraph, in the interests of advancing prosecution, and by way of example only and not to limit the scope of such claim terms thereto, Applicants below point out the support in the specification for the claim terms specified by the Examiner at the bottom of page 2 of the Office Action.

1) "treatment unit" : The electrode 3 in Fig. 2

2) "intermittent output control": The control circuit 13 and the timer 13a in the control circuit 13 in Fig. 2. The control circuit 13, according to the flow chart (Steps S11, S13 and S15) in Fig. 4, measures the output time and the rest time by the timer 13a, and intermittently controls the output.

3) "subject tissue determining unit": The control circuit 13 in Fig. 2. The control circuit 13, according to the flow chart (Steps S3 - S7) in Fig. 4, determines subject tissue such as thick blood vessel, middle blood vessel, fine blood vessel etc. by the time to

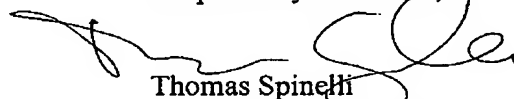
reach the high frequency current maximum value I_{max} of the first electric power WO and the high frequency current maximum value I_{max} as shown in Fig. 5.

4) "intermittent output setting unit": The control circuit 13 and the counter 13b in the control circuit 13 in Fig. 2. The control circuit 13, according to the flow chart (Steps S8- S16) in Fig. 4, sets the output electric power (W_1 , W_2 , and W_3) for controlling the power supply circuit 6 and the waveform shaping circuit 8 (Fig. 2) based on the result of subject tissue determination, and also sets the number of outputs measured by the counter 13b. As seen from the flow chart in Fig. 4, the number of outputs measured by the counter 13b is made such that the number of outputs of W_1 , W_2 , and W_3 , i.e. three times for the thick blood vessel is 3, the number of outputs of W_2 and W_3 , i.e. twice for the middle blood vessel is 2, and the number of outputs of W_3 , i.e. once for the fine blood vessel is 1.

Accordingly, it is respectfully requested that the rejection of claims 1-4 and 11 under 35 U.S.C. § 112, first paragraph, be withdrawn.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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